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PR

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/388,334 09/01/99 COONAN

G STINGER-UTIL

EXAMINER

PM82/1023

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ART UNIT

PAPER NUMBER

3634

DATE MAILED:

10/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/388,334

Applicant(s)

COONAN-ET AL.

Examiner

Jennifer E. Novosad

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-5, 6-9, 10-16, and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the recitation "at least three" (attached rotatable members), as claimed in claims 1, 6, 10, and 17, in the specification. It is noted that the specification states a "plurality" (see page 5, lines 13-14), "five" (see page 8, lines 16-17), and "preferably at least greater than four" (see page 8, line 18). Thus, "at least three" is a new embodiment not previously disclosed or supported in the original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "said plurality of rotatable members" in lines 2 and 4.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-9, 6, 10-16, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markin *et al.* '522 in view of Eitel '213.

Markin *et al.* '522 disclose a vertically adjustable mobile workstation comprising a base (12) supported by a plurality, i.e., three, of rotatable members (20); a first arm (38) having a lower end and an upper end whereby a platform (50) is attached thereto; a security panel (see Figure 10) partially covering the devices (below 60a and 60); a second arm (30) having an upper end (at 39) that is hingedly attached to the lower end of the first arm and a lower end that is attached to the base, whereby a stop mechanism (at 39) is operably coupled between the first (38) and second arms (30) and a neutral stop mechanism (40) is coupled *between* the arms; a line passing through the upper and lower ends of the second arm (30) is disposed at a *fixed* acute angle relative to a line passing through the center of the base and the first arm (38) being rotatable between a first position and a second position; and the platform (50) has a hinged support (see Figure 11) movable between different angles. It is noted that the claims do not recite that the rotatable members are "attached" to the base and hence indirect attachment is not precluded.

The claims differ from Markin *et al.* '522 in requiring: (a) battery pack and compartment attached to the platform (see claims 8 and 14), (b) a wireless transceiver attached to the platform

(see claims 9, 15, and 19), (c) computer input and output devices supported by the platform (see claims 10 and 17), and (d) more than four rotatable members supporting the base (see claim 18). } ?

Eitel '213 discloses a vertically adjustable mobile workstation comprising a base (12 and 16) having a plurality of rotatable members, i.e., four wheels, attached to the base; a first arm (33) having a lower end and an upper end (at 37) whereby a platform (36) is attached thereto and a wireless transceiver (65) is attached to the platform and to the base (66); a second arm (29) having an upper end (at 26) that is hingedly attached to the lower end of the first arm and a lower end (at 31) that is attached to the base, whereby a stop mechanism (at 34) is operably coupled between the first (33) and second arms (29); a line passing through the upper and lower ends of the second arm (29) is disposed at an acute angle relative to a line passing through the center of the base (at 31) and the first arm (33) being rotatable between a first position (solid line in Figure 1) and a second position (dotted line in Figure 1); and the platform is movable between first and second angles which are dependent on the movement of the first arm. It is noted that the controls (56 and 57) are considered to define the input devices and the antenna (65) is considered to define the output device (see claim 10).

With respect to (a), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a battery and compartment on the platform of Markin *et al.* '522, for carrying batteries for assisting in repairing loss of power to the receiver.

With respect to (b) and (c), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the workstation of Markin *et al.* 522 with an input *and* output device and a wireless transceiver, for ease in use and increased capability of the station.

With respect to (d), although Markin *et al.* '522 disclose only three wheels supporting the base, it would have been an obvious engineering design choice to one of ordinary skill in the art at the time the invention was made to have provided the base with more than four wheels, for increased structural support and stability of the base by providing greater load distribution while allowing for ease in movement of the base.

***Response to Arguments***

Applicants' arguments with respect to claims 1, 3-5, 7-9, 6, 10-16, and 17-20 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection were necessitated by the amendment reciting "at least three" in line 10 of claim 1, line 10 of claim 6, and line 12 of claims 10 and 17, and "fixed" in line 13 of claim 1, line 9 of claim 6, line 15 of claim 10, and line 17 of claim 17.

In response to applicants' argument that Eitel and Markin *et al.* "are different from the mobile computer workstation claimed by applicants", it has been held that a prior art reference must either be in the field of applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicants were concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the claims of the instant invention have not been "misinterpreted to cover the motor vehicles shown in the newly cited art", as stated by the applicants (see the top of page 5), but rather the vehicles of Markin *et al.* and Eitel, in combination, read on the structure of the claims of the instant invention thereby meeting the limitations of the claims. Apparently, applicants are relying upon the specification to impart to the claims, limitations

otherwise not recited therein. This reliance is ineffective. Moreover, patentability is to be based on the structural recitations of the device set forth in the claims and not how such device is intended to be used. Accordingly, what specific structural recitation, e.g., of claim 1, serves to structurally define the device as a "computer" workstation and otherwise preclude the "vehicle" of Markin *et al.* and/or Eitel from reading thereon ?

Regarding applicants' arguments concerning Eitel, in the first paragraph on page 5, it is noted that Eitel has been applied in combination with Markin *et al.*, to show the use of input and output devices.

Applicants' arguments concerning Markin *et al.*, in the first full paragraph on page 5, are acknowledged. However, it is noted that Markin *et al.* teach only two wheels on the base.

### ***Conclusion***

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703)-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-3597 for regular communications and (703)-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.

Jennifer E. Novosad/jen  
October 17, 2001



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
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